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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,294	08/10/2001	Robert M. Best	493-27-3	8277

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EXAMINER

WHITE, CARMEN D

ART UNIT	PAPER NUMBER
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3714

9

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,294

Applicant(s)

BEST, ROBERT M.

Examiner

Carmen D. White

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-144 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-144 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, 15-28 drawn to a method for use in an electronic video game system having at least one portable control unit that includes the step of generating an object, classified in class 463, subclass 36.
- II. Claims 6-14, drawn to a method for use in an electronic video game system that includes the step of generating a first and a second object, classified in class 463, subclass 36.
- III. Claims 29-41, 67-72, 87-92, drawn to a method for use in an electronic video game system that includes the steps of indicating selectable preprogrammed tasks and initiating a preprogrammed task classified in class 463, subclass 36.
- IV. Claims 42, 102-105, drawn to a method for use in an electronic video game system that includes the step of accepting a selection signal input, classified in class 463, subclass 36.
- V. Claims 43-63 drawn to a method for use in an electronic video game system that includes the step of storing animation data, classified in class 463, subclass 43.
- VI. Claims 64-66, drawn to a method for use in an electronic video game system that includes the step of displaying animated pictures on a display unit, classified in class 463, subclass 31.

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- VII. Claims 73-75, drawn to a method for use in an electronic video game system that includes generating a simulated world with at least one generated player controlled character having a plurality of movable parts, classified in class 463, subclass 30.
- VIII. Claims 76-86, drawn to a method for use in an electronic video game system having a disk reader that includes reading encrypted information, classified in class 463, subclass 43.
- IX. Claim 93, drawn to an apparatus for operating a video game console which displays an image that includes a hand-holdable housing having a shape for being grasped, classified in class 463, subclass 38.
- X. Claims 94-96, drawn to a method for use in an electronic video game system that includes the step of storing a series of records, classified in class 463, subclass 43.
- XI. Claim 97, drawn to a video game accessory, classified in class 463, subclass 47.
- XII. Claims 98-101, drawn to a method for use in an electronic video game system that includes the step of generating an object viewed from a variable angle, classified in class 463, subclass 31.
- XIII. Claims 106-111, drawn to a method for use in an electronic video game system having a touch-sensitive control member that detects any changes in finger location, classified in class 463, subclass 37.

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- XIV. Claims 112-115, drawn to a method for use in an electronic video game system that includes modifying a portion of an animated object during performance of an initiated task, classified in class 463, subclass 31.
- XV. Claim 116, drawn to a method for use in an electronic video game system that includes displaying a picture of a first object and a second object, classified in class 463, subclass 31.
- XVI. Claims 117-124, drawn to an electronic video game apparatus that includes data storage locations that store a first and second image, classified in class 463, subclass 43.
- XVII. Claims 125-126, drawn to an adapter apparatus for use with a portable game unit, classified in class 463, subclass 47.
- XVIII. Claims 127-128 and 131-133, drawn to a method for use in an electronic video game system having processors that includes generating an object having at least two independently controllable movable parts, classified in class 463, subclass 37.
- XIX. Claims 129-130 and 134-144, drawn to a method for use in an electronic video game system that includes reading authentication information, classified in class 463, subclass 2.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III, IV, V, VI, VII, VIII, X, XII, XIII, XIV, XV, XVIII and XIX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable.

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In the instant case, invention I has separate utility from the rest of the aforementioned groups, such as for generation of an object using one portable control unit; invention II has separate utility from the rest of the aforementioned groups, such as for generating a first and second object; invention III has separate utility from the rest of the aforementioned groups, such as for indicating selectable preprogrammed tasks and initiating a preprogrammed task; invention IV has separate utility from the rest of the aforementioned groups, such as for accepting a selection signal input; invention V has separate utility from the rest of the aforementioned groups, such as for storing animation data; invention VI has separate utility from the rest of the aforementioned groups, such as for displaying animated pictures on a display unit; invention VII has separate utility from the rest of the aforementioned groups, such as for generating a simulated world with at least one generated player controlled character having plural movable parts; invention VIII has separate utility from the rest of the aforementioned groups, such as for reading encrypted information; invention X has separate utility from the rest of the aforementioned groups, such as for storing a series of records; invention XII has separate utility from the rest of the aforementioned groups, such as for generating an object viewed from a variable angle; invention XIII has separate utility from the rest of the aforementioned groups, such as for having a touch-sensitive control member that detects any changes in finger location; invention XIV has separate utility from the rest of the aforementioned groups, such as for modifying a portion of an animated object; invention XV has separate utility from the rest of the aforementioned groups, such as for displaying a picture of a first object and a second object; invention

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XVIII has separate utility from the rest of the aforementioned groups, such as for generating an object having at least two independently controllable movable parts; invention XIX has separate utility from the rest of the aforementioned groups, such as for reading authentication information. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: (I, II, III, IV, V, VI, VII, VIII, X, XII, XIII, XIV, XV, XVIII and XIX), IX, XI, XVI and XVII. These claims disclose patentably distinct embodiments claims I, II, III, IV, V, VI, VII, VIII, X, XII, XIII, XIV, XV, XVIII and XIX are drawn to an embodiment of a method for use in an electronic video game system. Whereas, invention IX is drawn to an embodiment of an apparatus for operating a video game console; invention XI is drawn to an embodiment for a video game accessory; invention XVI is drawn to an embodiment for an electronic video game apparatus that includes data storage; and invention XVII is drawn to an embodiment for an adapter apparatus for use with a portable game unit.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims

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readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

USPTO Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.



cdw



S. THOMAS HUGHES
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